

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES S. OMANN

Appeal No. 2000-0027
Application No. 09/072,190

ON BRIEF

Before CALVERT, ABRAMS, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 19, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a composition, method and use of reduced roofing waste materials as a patch for potholes and a paving for roads, driveways, walkways and the like (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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|-----------------------------------|-----------|----------|
| Bladykas 1980 | 4,236,675 | Dec. 2, |
| Gaudio et al. 1993 (Gaudio) | 5,223,032 | June 29, |
| Grzybowski 1993 | 5,236,497 | Aug. 17, |

Claims 12 to 15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 12 to 15 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellant, at the time the application was filed, had possession of the claimed invention.

Claims 5, 12, 13 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gaudio in view of Grzybowski.¹

Claims 1 to 3, 6, 8 to 10, 14, 17 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gaudio as applied to claims 5, 12, 13 and 16 above, and further in view of Grzybowski.

Claims 4, 7, 11, 15 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gaudio as applied to claims 5, 12, 13 and 16 above, and further in view of Bladykas.

¹ While the examiner has included Grzybowski in the statement of this rejection, Grzybowski has not been relied upon in the body of this rejection. Thus, we consider this rejection of claims 5, 12, 13 and 16 under 35 U.S.C. § 103 as being based on Gaudio alone.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 5, mailed November 2, 1998) and the answer (Paper No. 11, mailed May 4, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 10, filed April 2, 1999) and reply brief (Paper No. 13, filed July 6, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We sustain the rejection of claims 12 to 15 under 35 U.S.C. § 112, second paragraph.

In the final rejection (p. 3) and the answer (p. 5), the examiner set forth his rationale as to why claims 12 to 15 were indefinite. Specifically, the examiner noted that the phrase ".3 by weight" in line 5 of claim 12 should be --.3 percent by weight --.

The appellant has not specifically contested this rejection in the brief or reply brief. In fact, the appellant agrees with the examiner that claim 12 should be corrected and asks that this be corrected by an Examiner's Amendment (brief, p. 5). Since

claim 12 has not been amended to correct this error, we summarily sustain the rejection of claims 12 to 15 under 35 U.S.C. § 112, second paragraph.

The written description rejection

We will not sustain the rejection of claims 12 to 15 under 35 U.S.C. § 112, first paragraph.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the appellant's disclosure a description of the

invention defined by the claims. See In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976); Ex parte Sorenson, 3 USPQ2d 1462, 1463 (Bd. Pat. App. & Inter. 1987).

The examiner determined (answer, p. 5) that the written description on page 17 of the originally filed application fails to provide written description of the "95 to .5 percent by weight aggregate" recited in claim 12.

The appellant argues (brief, p. 4) that the table called "Rate" on originally filed page 17 provides the required support for the claimed "95 to .5 percent by weight aggregate." Moreover, the appellant argues (reply brief, pp. 2-3) that the range of 0% to 95% aggregate in the table called "Rate" on originally filed page 17 supports the narrower range claimed (i.e., 95 to .5 percent by weight aggregate) for the reasons set forth in Wertheim.

It is our opinion that the claimed language in dispute (i.e., 95 to .5 percent by weight aggregate) is described in the original disclosure for the reasons set forth by the

appellant. It is not necessary that the specification specifically identify all claimed narrower values which fall within the broader range as set forth in the original disclosure. Therefore, as a factual matter, persons skilled in the art would consider the claimed range to be part of appellant's original disclosure. Note In re Wertheim, 541 F.2d at 264, 191 USPQ at 98. Additionally, we note that original claim 12 recited "95 to .5 parts aggregate." Where an original claim supports the subject matter now being claimed, nothing more is required for compliance with the description requirement of the first paragraph of § 112. See In re Gardner, 475 F.2d 1389, 1391, 177 USPQ 396, 397, supplemental opinion, 480 F.2d 879, 879-80, 178 USPQ 149 (CCPA 1973) and In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973).

For the reasons set forth above, the decision of the examiner to reject claims 12 to 15 under 35 U.S.C. § 112, first paragraph, is reversed.

The obviousness rejections

We sustain the rejection of claims 12 to 19 under 35 U.S.C. § 103, but not the rejection of claims 1 to 11.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claims 5 to 7

Claim 5 recites a method of manufacturing and applying a pavement and patch material mixture comprising, inter alia, (a) reducing sticky abrasive roof waste to roof waste granules of a size on average of up to one inch; (b) mixing superheated aggregate to the shingle granules; (c) mixing rejuvenating oil to the granules and aggregate; (d) mixing an emulsifier to the rejuvenating oil, granules and aggregate; (e) mixing asphalt

concrete oil to the granules, aggregate, rejuvenating oil and emulsifier; (f) evenly applying the material mixture of asphalt concrete oil, granules, aggregate, rejuvenating oil and emulsifier to the surface to be paved; and (g) evenly applying compaction to the applied material mixture.

Gaudio discloses a particulated asphalt composition comprised generally of roughage, asphalt particulate and solvent.

Gaudio teaches that the roughage is formed from rubble comprised of crushed concrete, asphalt pavement, sand and/or stone, or any combination thereof. The roughage is crushed and screened to a gradient size ranging from 1/4" minus to 2" minus and preferably sized to approximately 5/8" minus gradient. The roughage then can be heated to eliminate moisture, although cold process preparation is viable at ambient temperatures exceeding 32 degrees Fahrenheit. Asphalt, the second component of the present invention, then is granulated into asphalt particulate. This is achieved by processing the asphalt through size reduction

equipment. The asphalt can be either virgin asphalt blocks or reclaimed asphalt-containing material such as roofing refuse. The asphalt particulate is sized from between 1/4" minus gradient to 2" minus gradient, preferably sized to approximately 3/4" minus gradient. The particulated asphalt and crushed roughage then are mixed together to form an asphalt-aggregate.

The asphalt-aggregate of Gaudio is then mixed with the third component of his invention which is a solvent. The solvent additive preferably is varied to correspond to construction or repair weather temperatures. In warmer temperatures, a water-based solvent is the preferable solvent additive. In pavement applications, the water constituent of the water-based solvent relatively rapidly evaporates from the cold mix composition after pavement construction or repair application, to leave a rigid compound capable of withstanding roadway pressures. In colder temperatures, an oil-based solvent is preferable to

prevent freezing of the solvent constituent within the composition and mixing equipment used to carry the solvent to the asphalt-aggregate for preparation of the end composition.

Gaudio discloses that in warmer temperatures, the preferred solvent is comprised of a water-based emulsion type rejuvenator, such as that known by the trade name "Reclaimite [sic, Reclamite]" by Witco Oil Co. of Oildale, Calif. According to Gaudio at column 5, lines 4-19, "Reclaimite" is a blend of oils suspended in water to form an emulsion capable of dispersing the oils to lubricate the product to which it is applied. With water as the carrier of these oils, the water is left to evaporate, leaving the oils to be absorbed by the subject product, thereby causing softening, reconditioning and rejuvenating of the subject asphalt product. Thus, after mixing the water-based solvent with the asphalt-aggregate, the final asphalt composition of the present invention can be stockpiled for thirty to sixty days to allow the water portion of the emulsion to evaporate.

Gaudio teaches that the percentage weights of component per composition vary from 75% weight composition roughage to 96% weight composition roughage, 2% weight asphalt particulate to 20%

weight asphalt particulate, and 1% weight solvent to 3% weight solvent.

With respect to claim 5, the examiner determined (answer, pp. 6-7) that it would have been obvious to evenly apply the particulated asphalt composition of Gaudio to a surface to be paved and to evenly apply compaction to the applied particulated asphalt composition in order to produce an evenly paved surface in view of Gaudio's teaching that his particulated asphalt composition was capable of being used for repairing or constructing paved areas.² Implicit in this

² The examiner's determination of obviousness (answer, p. 10) regarding the mixing of the components of "Reclaimite" is not part of the rejection under appeal and will not be considered by this panel of the Board. Likewise, the examiner's determination of obviousness (answer, p. 11) regarding the adding of additional emulsifier is not part of the rejection under appeal and will not be considered by this (continued...)

rejection is the examiner's view that the above noted modifications of Gaudio would result in a method which corresponds to the method recited in claim 5 in all respects.

The appellant argues (brief, pp. 6-8) that Gaudio does not disclose step (d) of claim 5 (mixing an emulsifier to the rejuvenating oil, granules and aggregate). We agree. While Gaudio does teach the step of mixing a water-based emulsion type rejuvenator³ (e.g., "Reclaimite") with the particulated asphalt (i.e., granules) and crushed roughage (i.e., aggregate), Gaudio does not teach or suggest the step of mixing an emulsifier to an already mixed mixture of rejuvenating oil, granules and aggregate. Thus, the examiner has failed to establish that the claimed subject matter of claim 5 would have been obvious at the time the invention was made to a person having ordinary skill in the art.

²(...continued)
panel of the Board.

³ Such a water-based emulsion type rejuvenator would inherently include a rejuvenating oil, water and an emulsifier. Note page 8, lines 5-6, of the brief wherein the appellant admits an emulsifier is present in Reclamite.

For the reasons set forth above, the decision of the examiner to reject claim 5, and claims 6 and 7 dependent thereon, under 35 U.S.C. § 103 is reversed.

Claims 1 to 4 and 8 to 11

Independent claim 1 includes the step of mixing emulsifier to the aggregate, roof waste granules and rejuvenating oil. Independent claim 8 includes the step of mixing emulsifier to the combined material mixture of granules, aggregate and rejuvenating oil.

We have reviewed the references to Grzybowski and Bladykas but find nothing therein which makes up for the deficiency of Gaudio discussed above regarding claim 8. Likewise, the teachings of the applied prior art are not suggestive of the above-noted mixing steps of claims 1 and 8. Accordingly, the decision of the examiner to reject claims 1 and 8, and claims 2 to 4 and 9 to 11 dependent thereon, under 35 U.S.C. § 103 is reversed.

Claim 12

The examiner determined (answer, p. 7) that Gaudio teaches in Example 1, a pavement and patch material that appears to meet the limitations of claim 12. The examiner noted that from the disclosure in column 5, lines 8-20, that "Reclaimite" in Example 1 would necessarily include an emulsifier.

The appellant argues (brief, p. 8) that claim 12 is allowable for the reasons provided with regard to claim 5. We do not agree. Claim 12 does not require the emulsifier to be added (i.e., mixed) to the combined material mixture of granules, aggregate and rejuvenating oil as recited in claim 5. Thus, the appellant's argument is not commensurate in scope with claim 12. Clearly, the pavement and patch material disclosed by Gaudio in Example 1 includes recycled asphalt roof waste, aggregate and "Reclaimite" (a solution of water, rejuvenating oil and an emulsifier).⁴

⁴ We note that a disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 (continued...)

For the reasons set forth above, the decision of the examiner to reject claim 12 under 35 U.S.C. § 103 is affirmed.

Claims 13 to 19

The decision of the examiner to reject claims 13 to 19 under 35 U.S.C. § 103 is also affirmed since the appellant has not argued separately the patentability of any particular claim apart from the others, thus allowing claims 13 to 19 to fall with claim 12 (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978); and 37 CFR § 1.192(c)(7) and (8)(iv)).

⁴(...continued)
F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

CONCLUSION

To summarize, the decision of the examiner to reject claims 12 to 15 under 35 U.S.C. § 112, second paragraph, is affirmed; the decision of the examiner to reject claims 12 to 15 under 35 U.S.C. § 112, first paragraph, is reversed; the decision of the examiner to reject claims 1 to 19 under 35 U.S.C. § 103 is affirmed with respect to claims 12 to 19 and reversed with respect to claims 1 to 11.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

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| IAN A. CALVERT |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| NEAL E. ABRAMS |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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